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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/266,155	03/10/1999	BURTON J. PRICE	MRA-PT001	5381

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/266,155

Applicant(s)

PRICE ET AL.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9, 11-14, 16, and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9, 11-14, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 13, 2003, has been entered.

Response to Amendment

2. Amendment C filed on *June 13*, 2003, has been entered. Claims 7, 9, 11, and 13 have been amended, while claims 10 and 15 have been cancelled. New claims 16 and 17 have been added. Thus, the pending claims are 7-9, 11-14, 16, and 17.

Claim Rejections - 35 USC § 102/103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 7 and 8 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 4,112,161 issued to Sorrells for the reasons of record.

5. Claims 9 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as obvious over the cited Sorrells patent.

Applicant has amended independent claims 9 and 13 to include the permeability as measured in rays. As noted in the previous Office Actions, Sorrells does not explicitly teach the claimed permeability value. However, it is reasonable to presume the claimed permeability is inherent to the invention of Sorrells. Support for presumption is found in the use of like materials (i.e., tufted primary backings, discontinuous polymeric adhesive layers, and a secondary backing) and in like objectives (i.e., to provide a breathable carpet). The burden is upon Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the presently claimed permeability would obviously have been present when the carpet of Sorrells is provided. Note *In re Best*, 195 USPQ at 433, as to the providing of this 103 rejection with the above 102 rejection. Therefore, claims 9 and 11-14 are rejected as being anticipated or obvious over the cited prior art.

6. Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Sorrells patent.

7. New claims 16 and 17 differ from claims 7 and 9 in that the preamble is recited that the laminar assembly is three dimensional. However, this recitation is insufficient to overcome the cited Sorrells patent. Specifically, the recitation is merely a preamble limitation. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Additionally, the laminate assembly of Sorrells is

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inherently three dimensional in that it has a thickness, width, and length. Hence, claims 16 and 17 are rejected.

Response to Arguments

8. Applicant's arguments filed on with Amendment C have been fully considered but they are not persuasive.

9. Specifically, Applicant traverses the above Sorrells rejections by asserting that Sorrells achieves permeability by a mechanical means of punching holes, while the polymeric material of the present invention is made permeable "as it forms" and thus is "easier to produce" (Amendment C, page 6, 1st paragraph). In other words, the permeability is imparted in the polymeric material "after reheating and molding discussed in the application" (Amendment C, page 6, 2nd paragraph). Due to this difference, applicant feels the present claims are patentable distinguishable from the Sorrells invention.

10. The examiner respectfully disagrees. In particular, applicant's arguments are outside the scope of the claims. The claims are directed to a product, not a method. The claims do not even limit the method of making the polymeric layer permeable. The structural and chemical limitations of the presently claimed product are met by the disclosure of Sorrells. The polymeric layer of the prior art and of the present invention are both permeable. Thus, it is irrelevant that products are made by different processes.

11. With respect to applicant's argument that "the sound attenuation properties in the claimed invention is an advantage that was never addressed in Sorrells" (Amendment C, page 6, 1st paragraph), it is once again asserted that applicant's argument is outside the scope of the claims.

The claims do not limit the sound attenuation properties of the invention. Only claim 9 even mentions that the carpet panel is sound insulating. However, it is asserted that the invention of Sorrells meets this preamble limitation in that the tufted floor covering of Sorrells inherently provides some sound insulation properties. Also, Thus, applicant's arguments are unpersuasive and the above rejections are maintained.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cheryl Juska whose telephone number is 703-305-4472. The Examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



CHERYL A. JUSKA
PRIMARY EXAMINER

cj
August 10, 2003